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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,904	12/28/1999	MARK S. CHEE	A-67493-2RFT	1618

7590 11/18/2002

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EXAMINER

FRIEND, TOMAS H F

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/473,904

Applicant(s)

CHEE ET AL.

Examiner

Tomas Friend

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **Detailed Action**

### **Change of Art Unit Designation**

**Please note:** The Art Unit location of this application in the PTO has changed from Art Unit 1627 to Art Unit 1639. To aid in matching papers to this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

### **Status of the Application**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 August 2002 has been entered.

Receipt is acknowledged of a response to an office action with amendment on 29 August 2002 (Paper No. 19)

### **Status of the Claims**

Claims 18-34 were pending in the application. New claims 35 and 36 were added in Paper No. 19. Claims 18-36 are pending and examined on their merits.

### **Withdrawn Rejections**

1. The rejection of claims 18, 20, 22, 23, and 29-32 under 35 U.S.C. 102(e) as being anticipated by Walt et al. (February 2000, filed March 1997) U.S. Patent 6,023,540 is withdrawn.

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2. The rejection of claims 18-32 under 35 U.S.C. 103(a) as being unpatentable over Walt et al. US Patent No. 6,023,540, Geysen US Patent No. 5,595,915, and Brenner US Patent No. 5,763,175 is withdrawn.

3. The rejection of claims 33 and 34 under 35 U.S.C. 103(a) as being unpatentable over Walt et al. US Patent No. 6,023,540 is withdrawn.

#### **Maintained Rejections - 35 U.S.C. 112, first paragraph**

4. Claims 20, 33, and 34 remain rejected under 35 U.S.C. 112, first paragraph, (New Matter) for reasons made of record in Paper No. 13. Applicants have not traversed this rejection.

#### **New Grounds of Rejection**

The statutory basis for each of the following rejections not found below may be found in a prior office action.

#### **New Grounds of Rejection – 35 U.S.C. 112, second paragraph**

5. Claims 18-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 18 and 35 recite “...*each assay location comprising an array location comprising a plurality of discrete sites...*” It is not clear if an assay location is an array location. Clarification is requested.

B. Claims 18-34 recite “*array*” while claims 35 and 36 recite “*composite array*” but it is not clear from the specification how the metes and bounds of the two terms differ. Clarification is requested.

C. Claims 19 and 36 recite the limitation “*said sample*” (not one or more samples) in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

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D. In claim 19, it is not clear if microspheres are distributed at one array location as one microsphere per discrete site and not distributed at any other array location or if microspheres are distributed at one array location as one microsphere per discrete site and as more than one microsphere per discrete site at other array locations.

### **Allowable Subject Matter**

6. Claims 18 and 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

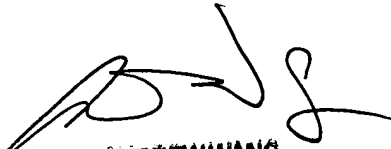
Applicant is advised that should claims 18 and 19 be found allowable, claims 35 and 36 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tomas Friend** at telephone number (703) 308-4548. The examiner's normal schedule is four, ten-hour days per week including Saturdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1235.

Tomas Friend, Ph.D.  
16 November 2002

  
**ANDREW WANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**